

REMARKS

Claims 1-31 are pending in the present application. In the Office Action mailed October 25, 2005, the Examiner rejected claims 1-3, 7, 8, 10, 11, 17, 18, 22-25, 30 and 31 under 35 U.S.C. §103(a) as being unpatentable over Ehman (USP 5,592,085) and in view of Nichtnennung (DE 103 56 046 A1). The Examiner next rejected claims 4-6, 9, 12-16, 19-21, and 26-29 under 35 U.S.C. §103(a) as being unpatentable over Ehman as applied to claims 1, 18 and 24 above, in view of Nichtnennung and further in view of Friedlander (USP 5,313,945).

The Examiner rejected claims 1, 18, and 24 under 35 U.S.C. §103(a) as being unpatentable over Ehman in view of Nichtnennung. Applicant respectfully disagrees.

The burden of establishing a prima facie case of obviousness falls on the Examiner. MPEP §2142. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a prima facie case, the Examiner must not only show that the combination includes each and every element of the claimed invention, but also provide “a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). That is, “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” MPEP §2143.01. “The fact that references can be combined or modified is not sufficient to establish prima facie obviousness.” *Id.* When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). Applicant believes that a prima facie case of obviousness has not been established and one cannot be made based on the art of record because there is no motivation to combine the references and the art of record fails to teach each and every element of the claimed invention.

The Examiner stated that “Ehman does not teach an emitter system constructed to emit an inaudible signal having properties to reduce perception of the system noise about at least a portion of the imaging area.” Office Action, Oct. 25, 2005, p. 2. The Examiner then stated that

“Nichtnennung teaches an emitter system constructed to emit an inaudible signal having properties to reduce perception of the system noise about at least a portion of the imaging area (see the abstract, provided with this Office action).” Id. The Nichtnennung reference provided by the Examiner is a German language patent. Only the Abstract of the Nichtnennung reference is in English and therefore, only the Abstract can be relied upon. Applicant would like to remind the Examiner that rejections based on abstracts are generally considered improper. MPEP §706.02. As is widely recognized, abstracts are commonly misleading, inaccurate, and incomplete. As such, MPEP §706.02 is clear that abstracts should only be relied upon in very limited circumstances. Specifically, “[i]n limited circumstances, it may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the abstract only without relying on the full text document.” Id. In these limited circumstances, “the full text document and a translation (if not in English) may be supplied in the next Office action.” Id. As such, should the Examiner find the following remarks unpersuasive, Applicant hereby requests the Examiner provide an English translation of the full text of DE 103 56 046 A1 with any subsequent action relying upon such and since Applicant must be given an opportunity to respond, any subsequent action should be non-final.

The Abstract of Nichtnennung does not teach that relied on by the Examiner. That is, the Abstract of Nichtnennung states, “Method for suppressing noise in the auditory apparatus of a human or animal whereby noise is detected as mechanical, electromechanical or acoustic waves. The detected noise is used to apply suppression signals to the auditory apparatus of a human or animal undergoing dental treatment.” Nowhere in the Abstract does Nichtnennung teach an emitter system constructed to emit an inaudible signal as called for in claim 1, emitting an inaudible signal configured to diminish auditory perception of a noise byproduct as called for in claim 18, or a parametric signal generator configured to generate ultrasonic signals as called for in claim 24. That is, the Abstract of Nichtnennung fails to teach that application of suppression signals to an auditory apparatus is accomplished using inaudible signals.

Since the English translated Abstract of Nichtnennung fails to teach emission of inaudible or ultrasonic signals, Nichtnennung does not teach that set forth by the Examiner. As such, the prior art used in the rejection of claims 1, 18, and 24 under 35 U.S.C. §103(a) fails to teach each and every element of the claimed invention. As stated above, should the Examiner find the preceding remarks unpersuasive, Applicant hereby requests the Examiner provide an English translation of Nichtnennung in a non-final action.

Furthermore, the Examiner stated that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to adapt the teaching of Nichtnennung with the teaching of Ehman to improve comfort level of the patient during imaging.” Office Action, *supra* at p. 2. Applicant respectfully disagrees.

Ehman relates to nuclear magnetic resonance imaging and teaches carrying out a scan using an NMR imaging system “while applying an oscillating stress to the object being imaged.” Abstract; see col. 1, lines 7-9. Ehman further teaches generating magnetic fields within the bore of a magnet of an NMR system. See col. 8, line 53-col. 9, line 10. Nichtnennung teaches detecting noise and applying “suppression signals to the auditory apparatus of a human or animal undergoing dental treatment.” Abstract. The Examiner has not provided a convincing line of reasoning why one skilled in the art would combine the dental apparatus of Nichtnennung with the NMR apparatus of Ehman. In fact, one skilled in the art would recognize that the introduction of the apparatus of Nichtnennung in the magnetic field of Ehman during NMR image acquisition may cause interference with the NMR system or may be hazardous to the patient. As such, one skilled in the art would not be motivated to combine the dental apparatus of Nichtnennung with the NMR system of Ehman.

Therefore, the Examiner has failed to establish a *prima facie* case of obviousness. As such, claims 1, 18, and 24, and the claims that depend therefrom, are believed patentable over the prior art.

Claims 4-6, 9, 12-16, 19-21, and 26-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ehman in view of Nichtnennung and further in view of Friedlander. Applicant respectfully disagrees with the Examiner with respect to the art as applied, but in light of claims 4-6, 9, 12-16, 19-21, and 26-29 depending from what is believed an otherwise allowable claim, Applicant does not believe additional remarks are necessary and, therefore, requests allowance of claims 4-6, 9, 12-16, 19-21, and 26-29 at least pursuant to the chain of dependency.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-31.

Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,

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